

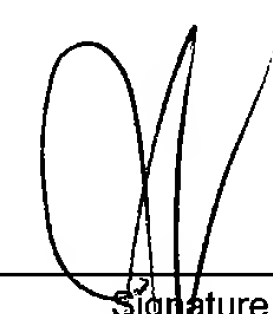
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PTO/SB/33 (12-08)

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PRE-APPEAL BRIEF REQUEST FOR REVIEW		Docket Number (Optional) 2222.4960001
I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)] on _____ Signature _____ Typed or printed name _____	Application Number 09/901,124	Filed July 10, 2001
	First Named Inventor William D. Meadow	
	Art Unit 3692	Examiner Nguyen, Nga B.
<p>Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.</p> <p>This request is being filed with a notice of appeal.</p> <p>The review is requested for the reason(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.</p> <div style="display: flex; justify-content: space-between; align-items: flex-start; margin-top: 20px;"><div style="width: 45%;"><p>I am the</p><p><input type="checkbox"/> applicant/inventor.</p><p><input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)</p><p><input type="checkbox"/> attorney or agent of record. Registration number _____</p><p><input checked="" type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 <u>43,447</u></p></div><div style="width: 50%; text-align: center;"> _____ Signature Jason D. Eisenberg _____ Typed or printed name (202) 371-2600 _____ Telephone number February 26, 2009 _____ Date</div></div> <p>NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.</p>		
<p><input checked="" type="checkbox"/> *Total of <u>1</u> forms are submitted.</p>		

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. **SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.**

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:

MEADOW *et al.*

Appl. No.: 09/901,124

Filed: July 10, 2001

For: **Check Authorization System and
Method**

Confirmation No.: 7209

Art Unit: 3692

Examiner: Nguyen, Nga B.

Atty. Docket: 2222.4960001

Arguments to Accompany the Pre-Appeal Brief Request for Review

Mail Stop: AF

Commissioner for Patents
PO Box 1450
Alexandria, VA 22313-1450

Sir:

Applicants hereby submit the following Arguments, in five (5) or less total pages, as an attachment to the Pre-Appeal Brief Request for Review Form (PTO/SB/33). A Notice of Appeal is concurrently filed.

Arguments

Applicants' arguments in the Reply under 37 C.F.R. § 1.111 filed August 7, 2008 and the Reply under 37 C.F.R. § 1.116 filed January 21, 2009 (collectively the "Replies"), filed in response, respectively, to the Office Action mailed June 9, 2008 and the Final Office Action mailed November 26, 2008 (collectively the "Prior Office Actions"), were not properly considered by the Examiner in the Final Office Action mailed November 26, 2008 ("Final Office Action") and the Advisory Action issued February 5, 2009 ("Advisory Action"). The Final Office Action was legally and factually deficient because it misapplied the law, and relied on speculation rather than actual evidence to support the allegations of obviousness. Indeed, given the absence of disclosure of all of the claimed features in the applied references to support the allegations of obviousness, the Final Office Action therefore appears to improperly rely upon the disclosure in the pending Application (i.e., impermissible hindsight) to maintain the rejection.

The Final Office Action rejected claims 3-5 and 9-14 as allegedly being obvious under 35 U.S.C. § 103(a) over U.S. Patent No. 6,611,598 to Hayosh (“*Hayosh*”). Applicants respectfully traverse.

1. *The Final Office Action Misapplies the Case Law Regarding the New Use of an Old Invention*

Applicants’ claims are not merely an intended use of a old product since the Examiner states the reference must be modified to meet the claim features.

A significant portion of Applicants' Replies focused on the fact that "adapted to receive checks," "adapted to print," "adapted to verify checks," "configured to receive information" and "configured to access" are "functional limitation[s that] must be evaluated and considered, just like any other limitation of the claim, for what [they fairly convey] to a person of ordinary skill in the pertinent art." *See After Final Reply at p. 8 (referring to M.P.E.P. § 2173.05(g))*. In contrast, the Examiner states in the Final Office Action that such features are merely "intended uses," and that "a new intended use for an old product does not make a claim to that old product patentable." *See Final Office Action at p. 4 (citing In re Schreiber, 44 USPQ2d 1429 (Fed. Cir. 1997))*.

The Examiner misapplies *Schreiber*. To the extent that "an intended use" of a product may serve as the basis for a rejection, the product must be "an **old** product," that is a product that has **not** been modified. However, the Examiner concedes that the *Hayosh* system requires "modification" in order to render the claims obvious. *See Final Office Action at p. 4 (stating "modify Hayosh's [computer system] to include the feature")*. Since the Examiner concedes the necessity of a modification to *Hayosh*, then *Schreiber* is not applicable law. *Schreiber* does not apply because the Examiner statement is not the case of a "new use" (intended or otherwise) of an **old** product since the Examiner states there must be a modification of *Hayosh* to meet the claims. Therefore, the application of *Schreiber* is without merit. Accordingly, Applicants request that the rejection of the claims on this basis be withdrawn.

2. *The Final Office Action Merely Speculates And Does Not Meet Its KSR Burden of Providing Actual Evidence of Obviousness*

As the U.S. Supreme Court has required, the "analysis [of obviousness] should be made explicit." *KSR Int'l Co. v. Teleflex Inc.*, 127 S.Ct. 1727, 1740-41 (2007) (citing *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006)). "[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." *Id.*

The Examiner has not met the *KSR* burden in the Final Office Action since the Examiner provides no evidence to support the bare conclusion that the claims are obvious. As a preliminary matter, the Final Office Action notes a difference between the pending claims and the applied reference in that "Hayosh fails to discuss the intended use which is to receive and print the hash value ... in the MICR line of a check." *See Final Office Action at p. 4.* However, the Final Office Action then summarily concludes in the very next sentence that "Hayosh's computer system is capable of printing and verifying the hash value ... in the MICR line of a check" and "[t]herefore, it would have been obvious to one with ordinary skill in the art at the time the invention was made to modify Hayosh's [computer system] to include the feature above for the purpose of enhancing the security in processing a check." *Id.*

Despite the Supreme Court's requirement for an explicit analysis, the Final Office Action provides no factual evidence to support such a bare obviousness assertion. Firstly, the Final Office Action fails to indicate **where in the reference** the feature of "to print a ... hash value ... on the MICR line" of a check may be found. Absent some evidentiary indication of a disclosure of this feature in the reference, the obviousness rejection is without proper foundation and should be withdrawn.

Moreover, even assuming that such evidentiary support was provided, evidence that merely serves to show that the *Hayosh* system can be modified is not enough. Rather, the evidence must show that it "would have been **predictable** to one of ordinary skill in the art." *See M.P.E.P. § 2143.01(III)*. The Examiner's alleged motivation of "enhancing the security in processing a check" is insufficient under the law. *See Final Office Action at p. 4.* Such an alleged motivation is too general since it could cover almost any modification contemplated

of *Hayosh*. In particular, the Examiner's allegation does not indicate why the specific modification of "to receive and print the hash value ... in the MICR line of a check" would have been predictable to one of ordinary skill in the relevant art *at the time of the invention*.

Accordingly, absent any factual evidence to support the assertion that the alleged *Hayosh* modification can be found in the reference, and that such a modification to *Hayosh* would have been predictable, the Final Office Action is deficient in meeting the requirement under *KSR* to show obviousness. Therefore, Applicants request that the rejection of the claims on this basis be withdrawn.

3. *The Final Office Action Rejection is Improper Since It Is Based on Impermissible Hindsight*

The Examiner is relying on impermissible hindsight to reject the pending claims. A finding of obviousness must be reached on the basis of facts gleaned from the reference. *M.P.E.P.* § 2142. Conversely, an Office Action rejection that takes advantage of the hindsight afforded by the pending claims to view the reference is impermissible. *Id.*

The Final Office Action asserts that "it would have been obvious to one with ordinary skill in the art at the time the invention was made to modify Hayosh's [computer system] to include the feature above for the purpose of enhancing the security in processing a check." *See Final Office Action at p. 4.* However, the Final Office Action provides no evidence outside of Applicants' disclosure that would suggest the claims. Specifically, the Final Office Action fails to identify any particular citation within *Hayosh* (or any other reference) that suggests the recited feature or suggests incorporating this feature into the MICR line of a check. Therefore, absent any such showing in the Final Office Action, it appears that the rejection is based on the Applicants' disclosure, and not on a reference as required under 35 U.S.C. § 103. Such an absence of a reference with this evidence leads to the conclusion that impermissible hindsight has been used. Accordingly, such a rejection is therefore improper, and Applicants respectfully request that the rejection be withdrawn.

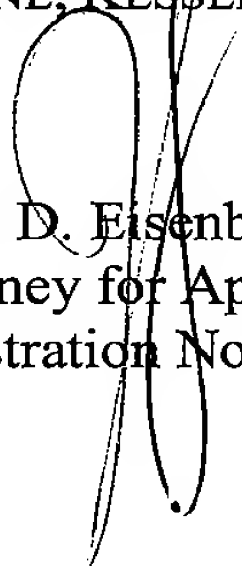
4. Conclusion

In view of the foregoing, Applicants respectfully request reconsideration and withdrawal of the rejections under 35 U.S.C. § 103(a) of claims 3-5 and 9-14 over *Hayosh*.

The U.S. Patent and Trademark Office is hereby authorized to charge any fee deficiency, or credit any overpayment, to our Deposit Account No. 19-0036.

Respectfully submitted,

STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C.


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Date: February 26, 2009

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